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10/597,862	04/28/2008	Thomas J. Kenney	042933/314689	7260

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EXAMINER
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TAYLOR, BARRY W

ART UNIT	PAPER NUMBER
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2617

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,862	<b>Applicant(s)</b> KENNEY, THOMAS J.	
	<b>Examiner</b> Barry W. Taylor	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

1. The applicant claims priority to **PCT/IP2005/000333** however a reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76). Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-7, 9, 12-15, 18-20, 22-24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Muthuswamy et al (20040137893).

Regarding claim 1, Muthuswamy et al disclose a system where a user reports his communication device as stolen by calling the service provider or carrier operating the communication system. Once the device is reported stolen, access to the communication system by the communication device is locked (i.e. disabled), and the memory is erased (see paragraph 37 and figure 4), which reads on the claimed, "system that limits mobile device functionality via a wireless network, comprising: an

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input component that receives a remotely originated request to disable the mobile device; and a disabling component that limits access to memory within the mobile device based on the request."

Regarding claim 2. Muthuswamy et al disclose that the communication device includes the security application 165 that processes security messages received and can be programmed into the communication device. The security application initiates the complete erasure of the information memory (see paragraphs 31-32), which reads on the claimed, "the request activates a pre-programmed security feature stored within the mobile device."

Regarding claim 3. Muthuswamy et al disclose that once the device is reported stolen, the memory can be erased (see paragraph 37 and figure 4), which reads on the claimed, "the security feature erases data stored in the mobile device's memory."

Regarding claim 6. Muthuswamy et al disclose that the invention can be a wireless communication system or the communication system could use Bluetooth, among other protocols (see paragraph 17), which reads on the claimed, "the wireless network protocol is one of an '1S2000, a CDMA, a TCDMA, a WCDMA, a TDMA, a FDMA, a GSM, a PCS, a Bluetooth, a Wi-Fi, a Cellular and a GPS protocol."

Regarding claim 7. Muthuswamy et al disclose that the communication network sends a message to the device to disable it (see paragraph 37), which reads on the claimed, "the request is broadcast to the mobile device via one of a one-time transmission, a periodic transmission and a continuous transmission."

Regarding claim 9. Muthuswamy et al disclose that the device is locked, the memory is erased, and optionally, hardware can be disabled (see paragraph 37 and figure 4), which reads on the claimed, "the disabling component further limits mobile device access via at least one of a keypad lock, a voice lock, a screen blank-out and a deletion of the device memory."

Regarding claim 12. Muthuswamy et al disclose that the information is transferred from the stolen device to the backup server (see paragraph 37 and figure 4), which reads on the claimed, "the request further invokes remote storage of the data stored within the mobile device's memory."

Regarding claim 13. Muthuswamy et al disclose that the user can call the service provider or the carrier operating the communication system to report that the communication device is stolen (see paragraph 37), which reads on the claimed, "a signal outside the wireless network is utilized to send the request to disable the mobile device's memory," wherein the phone call may be outside the wireless network.

Regarding claim 14. Muthuswamy et al disclose that the communication device can be a mobile cellular telephone, a personal digital assistant or a laptop computer among other electronic devices (see paragraph 18), which reads on the claimed, "the system of claim 1 is employed in one of a laptop computer, a handheld computer, a notebook computer, a personal digital assistant, a mobile telephone and a desktop computer."

Regarding claim 15. Muthuswamy et al disclose a system where a user reports his communication device as stolen by calling the service provider or carrier operating

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the communication system. Once the device is reported stolen, access to the communication system by the communication device is locked (i.e. disabled), and the memory is erased (see paragraph 37 and figure 4), which reads on the claimed, "method that limits access to a mobile device utilizing a wireless network, comprising: receiving a request to disable the mobile device; broadcasting a disable signal to the mobile device; and disabling access to at least the mobile device memory."

Regarding claim 18. Muthuswamy et al disclose that the invention can be a wireless communication system or the communication system could use Bluetooth, among other protocols (see paragraph 17), which reads on the claimed, "broadcasting the signal via at least one of an IS2000, a CDMA, a TCDMA, a WCDMA, a TDMA, a FDMA, a GSM, a PCS, a Bluetooth, a Wi-Fi, a Cellular and a GPS protocol."

Regarding claim 19. Muthuswamy et al disclose that the communication device includes the security application 165 that processes security messages received and can be programmed into the communication device. The security application initiates the complete erasure of the information memory (see paragraphs 31-32), which reads on the claimed, "access is disabled via at least one of the mobile device's internal security features."

Regarding claim 20. Muthuswamy et al disclose that the device is locked, the memory is erased, and optionally, hardware can be disabled (see paragraph 37 and figure 4), which reads on the claimed, "disabling access to the device comprises one or more of blanking a screen, locking a keypad, locking a microphone, and deleting mobile device memory."

Regarding claim 22. Muthuswamy et al disclose that the communication device can be a mobile cellular telephone, a personal digital assistant or a laptop computer among other electronic devices (see paragraph 18), which reads on the claimed, "the method of claim 15 is employed in connection with at least one of a laptop computer, a handheld computer, a notebook computer, a personal digital assistant, a mobile telephone and a desktop computer."

Regarding claim 23. Muthuswamy et al disclose that the user can call the service provider or the carrier operating the communication system to report that the communication device is stolen (see paragraph 37), which reads on the claimed, "the disable signal is sent via a third-party network," wherein the phone call may be outside the wireless network.

Regarding claim 24. Muthuswamy et al disclose a system where a user reports his communication device as stolen by calling the service provider or carrier operating the communication system. Once the device is reported stolen, access to the communication system by the communication device is locked (i.e. disabled), and the memory is erased (see paragraph 37 and figure 4), which reads on the claimed, "method that disables functionality of a mobile device via a wireless network, comprising: receiving a disable signal from a remote location; extracting information from the disable signal; and disabling memory access of mobile device based on the extracted information."

Regarding claim 26. Muthuswamy et al disclose that the operations are performed via security notifications (see paragraph 32), which reads on the claimed, "the signal is embedded in the wireless network's signaling protocol."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-5, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muthuswamy et al (20040137893 hereinafter Muthuswamy) in view of Adams et al (7,103,367 hereinafter Adams).

Regarding claim 4. Muthuswamy disclose the request may be transmitted via a phone call (see paragraph 37).

However, Muthuswamy fails to expressly disclose it is verified based on a caller identification.

Adams teaches a method and system for locating misplaced mobile station and preventing its unauthorized use (abstract, col. 3 lines 17-55, col. 4 lines 1-12). Adams teaches user can call the lost mobile phone with another phone wherein the mobile phone will recognize the call is from a special number thereby allowing the owner of the phone the ability to find a misplaced phone (col. 4 lines 13-46, col. 9 lines 4-44, col. 9 lines 60-67, col. 10 lines 1-21, col. 10 lines 31-42). Adam also teaches the owner of the misplaced mobile phone can send a text message to the lost phone (col. 4 lines 20-28,



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col. 6 line 65 - col. 7 line 24, col. 8 lines 1-12, col. 8 lines 40-65, col. 9 lines 4-44, col. 9 lines 60-67, col. 10 lines 1-21, col. 10 lines 31-42).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the teachings of Muthuswamy to program a mobile phone to recognize a call from a special number as taught by Adams in order to provide a means for helping a user find a misplaced mobile station as disclosed by Adams.

Regarding claim 5, Muthuswamy fails to expressly disclose that the request to disable the mobile device is made by placing a wireless phone call that invokes the request.

Adams teaches a method and system for locating misplaced mobile station and preventing its unauthorized use (abstract, col. 3 lines 17-55, col. 4 lines 1-12). Adams teaches user can call the lost mobile phone with another phone wherein the mobile phone will recognize the call is from a special number thereby allowing the owner of the phone the ability to find a misplaced phone (col. 4 lines 13-46, col. 9 lines 4-44, col. 9 lines 60-67, col. 10 lines 1-21, col. 10 lines 31-42). Adam also teaches the owner of the misplaced mobile phone can send a text message to the lost phone (col. 4 lines 20-28, col. 6 line 65 - col. 7 line 24, col. 8 lines 1-12, col. 8 lines 40-65, col. 9 lines 4-44, col. 9 lines 60-67, col. 10 lines 1-21, col. 10 lines 31-42).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the teachings of Muthuswamy to program a mobile phone to recognize a call from a special number as taught by Adams in order to enable a user to

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place a call or send an SMS from another wireless phone so that a user can find his misplaced mobile station as disclosed by Adams.

Regarding claim 16, Muthuswamy does not expressly disclose authenticating the request with a mobile device owner.

Adams teaches a method and system for locating misplaced mobile station and preventing its unauthorized use (abstract, col. 3 lines 17-55, col. 4 lines 1-12). Adams teaches user can call the lost mobile phone with another phone wherein the mobile phone will recognize the call is from a special number thereby allowing the owner of the phone the ability to find a misplaced phone (col. 4 lines 13-46, col. 9 lines 4-44, col. 9 lines 60-67, col. 10 lines 1-21, col. 10 lines 31-42). Adam also teaches the owner of the misplaced mobile phone can send a text message to the lost phone (col. 4 lines 20-28, col. 6 line 65 - col. 7 line 24, col. 8 lines 1-12, col. 8 lines 40-65, col. 9 lines 4-44, col. 9 lines 60-67, col. 10 lines 1-21, col. 10 lines 31-42). Adams teaches some form of account number, full or partial social security number, or a special personal identification number can be used to authenticate the user in order to avoid possible abuse of the system (col. 8 lines 59-65).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the teachings of Muthuswamy to use some form of authentication as taught by Adams in order to authenticate the owner of a lost phone thereby avoiding possible abuse of the system as disclosed by Adams.

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4. Claims 8, 21, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muthuswamy et al (20040137893 hereinafter Muthuswamy) in view of Hayatake et al (US005734978A hereinafter Hayatake).

Regarding claim 8, Muthuswamy does not disclose a return signal to verify access to the mobile device memory has been limited.

In a similar field of endeavor, Hayatake et al disclose a system where after destroying the data in the phone, the control section transmits a destruction end signal to the telephone informing the user of the destruction (see column 5, lines 5-15 and figure 2B).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy et al with Hayatake et al to include the above destruction confirmation signal so that the legal owner of the stolen mobile telephone can confirm that the mobile telephone has been made unavailable as suggested by Hayatake et al (see column 5, lines 5-15).

Regarding claim 21. Muthuswamy fails to expressly disclose that the request to disable access to the device is transmitted upon an unauthorized use.

In a similar field of endeavor, Hayatake disclose a system where the request to disable the phone is repeated, and can only function when the cell phone is turned on and is registered (see column 6, line 66 - column 7, line 23), which reads on the claimed, "the request to disable access to the device is transmitted upon an unauthorized use," wherein turning the stolen cell phone on reads on unauthorized use.

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy with Hayatake to include the above transmission of the request when the cell phone is on in order to ensure that the request is received.

Regarding claim 25, Muthuswamy fails to disclose a return signal that indicates the functionality of the device has been disabled.

In a similar field of endeavor, Hayatake disclose a system where after destroying the data in the phone, the control section transmits a destruction end signal to the telephone informing the user of the destruction (see column 5, lines 5-15 and figure 2B).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy with Hayatake to include the above destruction confirmation signal so that the legal owner of the stolen mobile telephone can confirm that the mobile telephone has been made unavailable as suggested by Hayatake et al (see column 5, lines 5-15).

Regarding claim 27, Muthuswamy disclose a system where a user reports his communication device as stolen by calling the service provider or carrier operating the communication system. Once the device is reported stolen, access to the communication system by the communication device is locked (i.e. disabled), and the memory is erased (see paragraph 37 and figure 4), which reads on the claimed, "system that facilitates limiting device functionality, comprising: means for receiving a signal to disable device functionality; means for limiting device functionality based on the signal."

Muthuswamy fails to disclose means for transmitting a return signal indicating successful disabling of device functionality.

In a similar field of endeavor, Hayatake disclose a system where after destroying the data in the phone, the control section transmits a destruction end signal to the telephone informing the user of the destruction (see column 5, lines 5-15 and figure 2B).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy with Hayatake et al to include the above destruction confirmation signal so that the legal owner of the stolen mobile telephone can confirm that the mobile telephone has been made unavailable as suggested by Hayatake et al (see column 5, lines 5-15).

5. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muthuswamy et al (20040137893 hereinafter Muthuswamy) in view of Trommelen (US006813487B1).

Regarding claim 10. Muthuswamy fails to disclose a tracking component that utilizes the request to facilitate locating the mobile device.

In a similar field of endeavor, Trommelen discloses a system that determines a geographic location of a lost or stolen mobile device (see column 3, line 63 - column 4, line 24 and figure 3), which reads on the claimed, "tracking component that utilizes the request to facilitate locating the mobile device."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy with Trommelen to include the above locating the

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lost or stolen mobile device in order to assist in device recovery as suggested by Trommelen (see column 4, lines 25-54).

Regarding claim 11, Muthuswamy fails to disclose the tracking component employs one or more of a global positioning system, a homing beacon and an audio alarm.

In a similar field of endeavor, Trommelen discloses the locating system may employ a GPS receiver (see column 3, line 63 - column 4, line 24), which reads on the claimed, "the tracking component employs one or more of a global positioning system, a homing beacon and an audio alarm."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy with Trommelen to include the above GPS receiver in order to take advantage of a very accurate positioning system already in place.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muthuswamy et al (20040137893 hereinafter Muthuswamy) in view of Isikoff (US005748084A).

Regarding claim 17, Muthuswamy fails to disclose locating the mobile device after the disable signal has been sent.

In a similar field of endeavor, Isikoff discloses a system where when a computer is stolen, data on the laptop is destroyed, and finally, the signals transmitted by the cellular transceiver are externally tracked to determine the location of the computer (see column 8, line 22 - column 9, line 52).

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Muthuswamy with Isikoff to include the above locating the computer after destroying the data in order to assist in the recovery of the computer hardware as suggested by Isikoff (see column 9, lines 33-52).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Thursday, 6:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kent Chang, can be reached at (571) 272-7667. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Centralized Delivery Policy:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number **(571-273-8300)**.

/Barry W Taylor/

Primary Examiner, Art Unit 2617